

## REMARKS

### Summary

This response is in reply to the Final Office Action mailed June 23, 2008 ("the Office Action"). Claims 1, 4, 7-8, 10-11, 13-15, 17-20, 37-38, 40, 42-43, 45-46, 48-49, and 52 stand rejected. No amendments have been made in this response.

Claims 1, 4, 7-8, 10-11, 13-15, 17-20, 37-38, 40, 42-43, 45-46, 48-49, and 52 are currently pending.

### **Claims 1, 4, 7-8, 10-11, 13-15, 17-20, 37-38, 40, 42-43, 45-46, 48-49, and 52: Rejections Under 35 U.S.C. § 103(a)**

Claims 1, 4, 7-8, 10-11, 13-15, 17-20, 37-38, 40, 42-43, 45-46, 48-49, and 52 have been rejected under 35 U.S.C. § 103(a). Assignee respectfully traverses these rejections in view of the following remarks and arguments. In particular, Assignee respectfully submits that independent claims 1, 11, and 37 are allowable over the applied references and that, because independent claims 1, 11, and 37 are allowable, the claims that depend therefrom are also allowable.

#### **A. Claims 1, 4, 7-8, 10, and 45-46**

Independent claim 1 has been rejected as being unpatentable over Akiyama (CA 2377386) in view of Reynolds (U.S. Pat. No. 7,020,888), Blacketter (U.S. Pat. No. 7,159,232), Haas (U.S. Pat. App. Pub. No. 2002/0063714), and Zigmond (U.S. Pat. No. 6,698,020). However, independent claim 1 is patentable over these references, whether taken alone or in combination, for at least two reasons.

##### **1. Not all of the references teach or suggest all of the features of claim 1**

As a first reason, not all of the references teach or suggest all the features of independent claim 1. In particular, neither Akiyama nor Zigmond teach or suggest the features of independent claim 1 as asserted by the Office Action.

**a. Akiyama does not teach or suggest “determining whether a television broadcast has resumed after end of a television broadcast advertisement”**

The Office Action asserts that Akiyama teaches determining whether a television broadcast program has resumed after the end of a television broadcast advertisement. (Office Action, pp. 3-4). However, Akiyama does not teach or suggest this feature.

In the embodiment relied upon for the rejection, Akiyama discusses the selection of a commercial suited to the individual profile of a viewer. Akiyama explains that a selective display process is responsible for replacing a commercial originating from a tuner with a commercial originating from a hard disk memory. During the selective display process, a CF code for a commercial is determined from an advertiser/commercial table based on a viewer's attribute. (Akiyama, p. 26, ll. 23-27). After determining the CF code for the replacement commercial, the selective display process waits for a timer interrupt to occur. When the timer interrupt occurs, the selective display process activates a switcher to read the commercial with the selected CF code from the hard disk memory. The commercial with the selected CF code is then sent to a decoder for decoding and selective display process effectively replaces the commercial originating from the tuner.

However, the selective display process does not determine whether a television broadcast program has resumed after the end of the replacement commercial. Akiyama explains that the selective display process waits for the content of the replacement commercial to be read out. When the selective display processes finishes the readout of the replacement commercial, the selective display process sets the switcher back to an original state, and re-establishes the path between the tuner and the decoder, such that the television broadcast program is displayed from a previously scheduled point. (Akiyama, p. 27, ll. 6-10).

Accordingly, Akiyama does not teach or suggest determining whether the television broadcast program has resumed after the end of a television broadcast advertisement. As described above, the selective display process focuses on the duration of the replacement commercial and does not focus on whether the tuner has resumed the broadcast of the original television programming. Hence, Akiyama does not teach or suggest the feature

of determining whether the television broadcast program has resumed after the end of a television broadcast advertisement as asserted by the Office Action.

- b. Zigmond does not teach or suggest “retaining the viewer selection of the at least one modification to the first replacement advertising segment as part of the viewer profile” or “automatically applying the previously retained viewer selection of the at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment.”**

Zigmond does not teach or suggest the features of claim 1. According to the Office Action, Zigmond discusses developing a viewer profile based on viewer interaction with an advertising segment including retaining a viewer selection of at least one interaction with the first replacement advertising segment as part of the viewer profile and automatically applying the previously retained viewer selection of the at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment. (Office Action, p. 8). However, Zigmond does not discuss the claimed developing of the viewer profile nor does Zigmond discuss automatically applying the previously retained viewer selection for a first replacement advertising segment to a second replacement advertising segment that is received after the first replacement advertising segment.

Claim 1 recites that developing the viewer profile includes several actions including receiving a viewer selection of at least one modification to a first replacement advertising segment, rendering the at least one modification to the first replacement advertising segment, and retaining the viewer selection of the at least one modification to the first replacement advertising segment as part of the viewer profile. Claim 1 also recites automatically applying the previously retained viewer selection of the at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment. Zigmond does not teach or suggest these features.

Zigmond is generally directed to methods and systems for inserting advertisements or other video or visually displayed objects into video programming feeds at the household level. According to Zigmond, these methods allow advertisers to target individual viewers

based on the needs and interests of individual viewers and households. (Zigmond, col. 4, ll. 7-12). In one embodiment, Zigmond discusses a viewer monitoring feature that monitors viewer interactions with an advertisement. (Zigmond, col. 9, ll. 20-22). In this embodiment, the viewer monitoring feature monitors viewer actions and responses such as channel changes during the display of an advertisement, feedback provided by the viewer, or an advertisement selection when the viewer is presented with multiple advertisements. (Zigmond, col. 9, ll. 22-37). Zigmond explains that the viewer actions may be collected as part of statistics collection or may be used to modify the advertisement selection process. (Zigmond, col. 9, ll. 39-55).

The Office Action asserts that Zigmond teaches the features of claim 1 because Zigmond teaches “retaining the viewer selection of the at least one **interaction** with the first replacement advertising segment.” However, claim 1 recites “retaining the viewer selection of the least one **modification** to the first replacement advertising segment.” In contrast to claim 1, Zigmond is not related to modifying replacement advertisements. Zigmond primarily focuses on monitoring viewer responses to an advertisement. As discussed above, Zigmond monitors viewer responses relating to an advertisement, such as whether the viewer changes the channel or provides feedback for an advertisement, but Zigmond does not monitor modifications to an advertisement. Changing the channel on which an advertisement is displayed does not modify the advertisement, but changes the channel itself.

Moreover, Zigmond does not describe automatically applying a previously retained viewer selection of at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment. Zigmond explains how the viewer responses to an advertisement are used to modify the selection process for selecting an advertisement. Modifying the selection process for selecting an advertisement does not modify the advertisement, but modifies whether the advertisement is selected. As described in the application at pages 8-10 developing the viewer profile facilitates the display of replacement advertisements having similar modifications that were made to a previous replacement advertisement. Zigmond does not teach or suggest this feature.

**c. Conclusion**

Hence, Akiyama and Zigmond fail to teach or suggest the above-noted features of independent claim 1 as asserted by the Office Action. Because Akiyama and Zigmond fail to teach or suggest these features, independent claim 1 is patentable over the combination of Akiyama in view of Reynolds, Blackketter, Haas, and Zigmond. As claim 1 is patentable over these references, dependent claims 4, 7-8, 10, and 45-46 are also patentable over these references.

**2. Akiyama teaches away from the combination with Blackketter**

For a second reason of patentability, independent claim 1 is also patentable over Akiyama in view of Reynolds, Blackketter, Haas, and Zigmond because there is no suggestion or motivation to combine Akiyama with Blackketter. (See Manual of Patent Examining Procedure § 2143.01). In particular, Akiyama and Blackketter teach systems that operate according to conflicting principles and, because Akiyama and Blackketter teach systems that operate according to conflicting principles, Akiyama teaches away from the combination with Blackketter. As Akiyama teaches away from the combination with Blackketter, there can be no suggestion or motivation to combine the two references.

**a. A review of Federal Circuit caselaw shows that references are not properly combinable where the teachings of the references conflict**

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 U.S.P.Q.2d 1286, 1292 (Fed. Cir. 2001)). Application of the teaching-suggestion-motivation test is not a “rigid rule that limits the obviousness inquiry.” (*KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)). However, the conflicting teachings of references cannot be reasonably viewed as suggesting their combination. (*Karsten Mfg. Corp.*, 58 U.S.P.Q.2d at 1293). Moreover, where a first reference teaches away from a second

reference, there can be no teaching or suggestion to combine the two references. (*Winner Int'l Royalty Corp. v. Wang*, 53 U.S.P.Q.2d 1580, 1587-88 (Fed. Cir. 2000).

In *Karsten Mfg. Corp. v. Cleveland Golf Co.*, the Federal Circuit reversed the District Court's decision that claims 7 and 8 of U.S. Pat. No. 5,297,803 ("the '803 patent") were invalid as being obvious in view of the combination of a Wilson 1200 Power Sole club head and U.S. Pat. No. 5,011,151 ("the Antonius '151 patent"). Claim 7 is dependent on claim 1 and further refines the features of a top rail for a golf club iron-type head. Claim 8 is dependent on claim 7 and further refines the features of a top rail portion introduced by claim 7.

In reversing the District Court, the Federal Circuit found that there were structural differences between the Wilson 1200 Power Sole club and the Antonius '151 patent. Specifically, the Federal Circuit found that the Antonius '151 patent taught a top rail that was thicker at a heel and thinner at a toe, whereas the Wilson 1200 Power Sole club taught a top rail that was thinner at the heel and thinner at the toe. (*Karsten Mfg. Corp.*, 58 U.S.P.Q.2d at 1293). Due to these structural differences, the Federal Circuit explicitly stated that "[s]uch conflicting teachings can not reasonably be viewed as suggesting their combination into a head having the limitations set forth in claims 7 and 8." (*Id.*). Accordingly, the Federal Circuit found claims 7 and 8 valid in view of the combination of the Wilson 1200 Power Sole Club and the Antonius '151 patent.

In *Winner Int'l Royalty Corp. v. Wang*, the Federal Circuit affirmed the District Court's finding that claims 2 and 4 of U.S. Pat. No. 4,935,047 ("the '047 patent") were not obvious in view of the combination of four references: U.S. Pat. No. 4,738,127 ("the '127 patent"), U.S. Pat. No. 3,462,982 ("the '982 patent"), Taiwan Patent App. No. 74,210,699 ("WuROC"), and French Patent App. No. 2,566,398 ("Grimaldi"). The '047 patent is directed to an automobile anti-theft device that incorporates a self-locking ratcheting mechanism. The '127 patent is also directed to an automobile anti-theft device, but the '127 patent uses a dead-bolt mechanism rather than a self-locking ratcheting mechanism. (*Winner Int'l Royalty Corp.*, 53 U.S.P.Q.2d at 1582). The '982 patent allegedly made up for the deficiencies of the '127 patent because the '982 was alleged to have taught a self-locking ratcheting mechanism. (*Id.* at 1587). In conducting its analysis, the Federal Circuit

reasoned that “[i]f there was no motivation or suggestion to combine [the ’127 patent] with the ratcheting mechanism of [the ’982 patent], one of ordinary skilled in the art would not have viewed the invention of the ’047 patent as obvious.” (*Id.* at 1587).

When the obviousness question was originally before the District Court, the court had found that there was no motivation to combine the ’127 patent with the ’982 patent because the written description of the ’127 patent taught away from the ’982 patent. (*Id.* at 1587). The Federal Circuit recognized that “if [the ’127 patent] did in fact teach away from [the ’982 patent], then that finding alone can defeat Wang’s obviousness claim.” (*Id.*). In its obviousness analysis, the District Court focused on a structural difference identified in the ’127 patent. Specifically, the District Court identified a passage from the ’127 patent that described that the locking mechanism of the ’982 patent was exposed and could be easily overcome. Based on this passage, the District Court determined that the ’127 patent taught away from the ’982 patent. Although the Federal Circuit recognized the dispute was inherently factual, the Federal Circuit found that the District Court did not clearly err in finding that one of ordinary skill would not be motivated to combine the ’127 patent with the ’982 patent. (*Id.* at 1587).

**b. Akiyama describes a system for replacing broadcast commercials where the occurrence and duration of the replacement content for the replaced broadcast commercial is previously configured**

Akiyama describes a system for replacing broadcast commercials that operates according to static features. In one embodiment for replacing commercials, Akiyama describes that a system includes a tuner for receiving digital waves, a hard disk memory for accumulating contents of the received digital waves, a switcher for selecting the tuner or the hard disk memory, a decoder for decoding the received content, and a built-in clock for counting time. (Akiyama, p. 19, ll. 17-27). In this embodiment, Akiyama also describes several replacement mechanisms including a replacement management unit for control of updating the contents in the hard disk memory and a replacement control unit for controlling the switcher. (Akiyama, p. 19, ll. 24-27).

In this static system, Akiyama describes that the replacement content is delivered to the hard disk memory prior to replacing a commercial. Akiyama explains that the replacement content is a commercial to be replaced with a commercial in a specified program. Akiyama further describes that the replacement content is previously broadcast before a replacing target program is broadcast. (Akiyama, p. 20, ll. 10-15). Akiyama states that the replacement content includes a predetermined content code that identifies the replacement content. (Akiyama, p. 20, ll. 16-19).

In addition, Akiyama explains that the replacement content replaces a target program according to a replacement start time. Akiyama describes that when a replacement start time is reached, the replacement control unit replaces the target program being broadcast with the replacement content stored in the hard disk memory. (Akiyama, p. 21, ll. 5-15). Akiyama goes so far as to describe a static table that indicates when replacement content should replace a target broadcast program. For example, Akiyama describes the data structure of a program table that includes such fields as a "start time" field and a "televising time" field. (Akiyama, Fig. 8; Akiyama, p. 22, ll. 7-18). A timer startup process and a selective display process for replacing a target program being broadcast with selective replacement content use the static time fields described by Akiyama. (Akiyama, pp. 25-26, ll. 19-14).

Hence, the system described by Akiyama relies on static features for implementing the described TV tuner, such as a replacement content being broadcast before a target program and a program table that has previously configured time fields.

**c. Blackketter describes a system where the viewer controls the duration of an interactive session displayed during a commercial**

In contrast to Akiyama, Blackketter teaches a system that operates based on dynamic features that are in conflict with the teachings of Akiyama. In one embodiment, Blackketter describes that an interactive session is offered to the viewer during an advertisement. Blackketter further describes that the interactive session may provide an opportunity for the viewer to request additional information about an advertised product or service. (Blackketter, cols. 8-9, ll. 6-46).



One of the dynamic features employed by Blackketter is that the viewer controls the duration of the interactive session. For example, Blackketter explains that if an interactive session is still in progress when an advertisement is finished, then a television program is paused by recording the television program on a video recorder. (Blackketter, col. 9, ll. 15-20). Blackketter then explains that when the interactive session is finished, a receiver continues recording the television program using a video recorder and begins playing back the recorded program. (Blackketter, col. 9, ll. 25-28). In one example, Blackketter highlights that there may be a situation where an advertisement ends and the television program resumes before the viewer can finish the interactive session. Blackketter emphasizes that the receiver will begin recording the television program so that the viewer does not have to abandon the interactive session. (Blackketter, col. 9, ll. 35-55). Hence, unlike Akiyama, in which the duration of the replacement content is set according to a predetermined schedule, the duration of the interactive session is at the discretion of the viewer.

**d. Applying Federal Circuit caselaw, Akiyama teaches away from Blackketter because the system for replacing broadcast commercials in Akiyama conflicts with the system of displaying interactive sessions in Blackketter**

Akiyama teaches away from Blackketter because the system for replacing commercials in Akiyama conflicts with the system for displaying the interactive sessions as taught by Blackketter. Similar to the Antonius '151 patent of *Karsten Mfg. Corp.* or the '127 patent of *Winner Int'l Royalty Corp.*, Akiyama describes a specific structural arrangement of elements and these elements rely on static features for replacing a broadcast commercial. Likewise, Blackketter is analogous to the Wilson 1200 Power Sole club of *Karsten Mfg. Corp.* or the '982 patent of *Winner Int'l Royalty Corp.* in that Blackketter teaches a structural arrangement of elements for displaying an interactive session, but these elements conflict with Akiyama since these elements rely on dynamic features for displaying an interactive session during a broadcast commercial. Due to their conflicting teachings, Akiyama teaches away from the combination with Blackketter.

The accuracy and predictability found in Akiyama conflicts with the dynamic features described in Blackketter. For example, Akiyama relies on preconfigured schedules and a program detail that detail the start and duration times of television programs and advertisements. Akiyama operates by inserting replacement content into the television programs according to these received preconfigured schedules. Akiyama does not describe or suggest that the schedules or the times are modifiable after being received. Moreover, Akiyama does not describe or suggest a mechanism for altering the preconfigured schedules. A viewer using the system of Akiyama cannot change the duration of the replacement content nor can the viewer affect when the replacement content appears. However, the preconfigured schedules and the program table are fundamental to the operation of Akiyama. Akiyama relies on these static features to accurately and predictably determine the occurrence of the broadcast commercial to be replaced and the duration of the replacement content replacing the broadcast commercial.

In contrast, Blackketter emphasizes that a viewer controls the occurrence and duration of the interactive sessions. As Blackketter illustrates, the interactive sessions do not rely on preconfigured schedules, nor do the interactive sessions rely on the duration of any advertisements. The system described by Blackketter obviates any concept of predictability or accuracy that is found in Akiyama. One of ordinary skill in the art looking at Akiyama for the accuracy and predictability that Akiyama provides would not then turn to Blackketter to determine how to nullify that accuracy and predictability.

Like the impermissible combinations found in *Karsten Mfg. Corp.* and *Winner Int'l Royalty Corp.*, so too is the combination of Akiyama with Blackketter impermissible. While Akiyama and Blackketter may be related, the teachings of Akiyama conflict with the teachings of Blackketter. However, while the references were related in *Karsten Mfg. Corp.* and *Winner Int'l Royalty Corp.*, the Federal Circuit looked to the conflicting teachings of the references to determine that the references taught away from their combination. Much like one of ordinary skill in the art would not be motivated to either modify the Antonius '151 patent with the Wilson 1200 Power Sole club, or modify the '127 patent with the '982 patent, one of ordinary skill in the art would not be motivated to modify Akiyama with Blackketter.

**e. Conclusion**

Hence, there is no suggestion or motivation to modify Akiyama with Blackketter. Accordingly, independent claim 1 is patentable over Akiyama even in view of Reynolds, Blackketter, Haas, and Zigmond. As claim 1 is patentable over these references, dependent claims 4, 7-8, 10, and 45-46 are also patentable over these references.

**B. Claims 11, 13-15, 17-20, and 48-49**

Independent claim 11 has been rejected as being unpatentable over Akiyama in view of Reynolds, Blackketter, Haas, and Zigmond. However, for at least the same reasons as claim 1, independent claim 11 is also patentable over these references, whether taken alone or in combination.

**1. Not all of the references teach or suggest all of the features of claim 11**

First, not all of the references teach or suggest all of the features as asserted by the Office Action. Starting with Akiyama, the Office Action asserts that Akiyama teaches the feature of enhancing a television broadcast program comprises determining whether a next sequential program segment in the television broadcast program has commenced after end of the blocked television broadcast segment. (Office Action, pp. 10-11). However, similar to the discussion above with respect to claim 1, Akiyama does not teach or suggest this feature. As discussed previously, Akiyama describes a selective display process that focuses on the duration of a replacement commercial. In describing the selective display process, Akiyama does not address whether the tuner determines if the broadcast of the original television programming has resumed. Hence, Akiyama does not teach or suggest the features of independent claim 11 as asserted by the Office Action.

Turning next to Zigmond, Zigmond does not describe automatically applying a previously retained viewer selection of at least one modification to a second replacement advertising segment that is received after the first replacement advertising segment. (See

Office Action, pp. 15-16). As discussed above with respect to claim 1, Zigmond explains how the viewer responses to an advertisement are used to modify the selection process for selecting an advertisement. Modifying the selection process for selecting an advertisement does not modify the advertisement, but merely modifies whether the advertisement is selected. Hence, Zigmond is not related to modifying replacement advertisements.

## **2. Akiyama teaches away from the combination with Blackketter**

Moreover, there is no suggestion or motivation to combine Akiyama with Blackketter. As previously discussed with respect to claim 1, Akiyama describes a system that operates based on static features, and these features provide the elements of accuracy and predictability. In contrast, Blackketter describes a system that operates based on dynamic features, and these dynamic features obviate the elements of accuracy and predictability found in Akiyama. Hence, the teachings of Akiyama and Blackketter conflict such that Akiyama teaches away from the combination with Blackketter. Accordingly, as Akiyama teaches away from the combination with Blackketter, the teachings of the references are not sufficient to render the claims *prima facie* obvious. (MPEP § 2143.01).

## **3. Conclusion**

Accordingly, for at least the reasons that none of references teach or suggest all of the features of independent claim 11 whether taken alone or in combination, and that the modification of the references would change the principle operation of a reference, independent claim 11 is patentable over Akiyama in view of Reynolds, Blackketter, Haas, and Zigmond. As independent claim 11 is patentable, dependent claims 13-15, 17-20, and 48-49 4, 7-8, 10, and 45-46 are also patentable.

## **C. Claims 37, 38, 40, 42-43, and 52**

Claims 37, 40, 42, and 52 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Reynolds, Blackketter, Haas, and Zigmond. Claim

38 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Reynolds, Blackketter, Haas, Zigmond, and Pendakur (U.S. Pat. App. Pub. No. 2003/0016673). Claim 43 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Reynolds, Blackketter, Haas, Zigmond, and Huang (U.S. Pat. No. 6,437,836). However, independent claim 37 is patentable over all of these references, whether the references are taken alone or in combination.

Independent claim 37 recites features directed to a system that practices the methods recited by independent claims 1 and 11. Accordingly, for at least the same reasons as independent claim 1 and 11, independent claim 37 is patentable over Akiyama, Reynolds, Blackketter, Haas, and Zigmond, whether taken alone or in combination. As independent claim 37 is patentable over these references, dependent claims 40, 42, and 52 are also patentable over these references.

Dependent claims 38 and 43 are also patentable for at least the same reasons as independent claim 37. Neither Pendakur nor Huang make up for the deficiencies of Akiyama, Reynolds, Blackketter, Haas, or Zigmond. Pendakur is generally directed to a system and method for transmitting digital content and receiving feedback indicative of lost content that was not adequately received. (Pendakur, ¶0003). Pendakur is not directed to developing a viewer profile based on viewer interaction. Huang is generally directed to a handheld device for displaying information and transmitting codes to a remote receiver device to cause the remote device to tune to a selected program. (Huang, col. 1, ll. 8-12). Like Pendakur, Huang is not directed to developing a viewer profile based on viewer interaction. Hence, neither Pendakur nor Huang make up for the deficiencies of Akiyama, Reynolds, Blackketter, Haas, or Zigmond.

Accordingly, dependent claims 38 and 43 and patentable over Akiyama, Reynolds, Blackketter, Haas, Zigmond, Pendakur, and Huang, whether taken alone or in combination, for at least the same reasons as independent claim 37.

## **Conclusion**

Therefore, in view of the above remarks, Assignee respectfully submits that this application is in condition for allowance and such action is earnestly requested.

If for any reason the Examiner is not able to allow the application, he is requested to contact the Assignee's undersigned attorney at (312) 321-4200.

Respectfully submitted,

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